

### **REMARKS**

The Final Office Action of April 22, 2004 has been carefully reviewed and these remarks are responsive thereto. Claims 15-25, 27-40 and 43-55 remain pending in this application. Reconsideration and allowance of the instant application are respectfully requested based upon the following arguments. No amendments have been made to the claims. The listing of the claims is provided for the Examiner's convenience.

### **Claim Rejections**

#### **Independent Claims 16 and 43**

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ludwig et al.*, U.S. Pat. No. 5,854,893 (*Ludwig*), in view of U.S. Pat. No. 5,924,082 (*Silverman*). Applicants respectfully traverse for the following reasons.

*Silverman* does not teach or suggest the feature of “advertising an invitation to join a group by posting an advertisement for prospective group members, wherein at least some of the prospective group members are unknown to a user creating the networked environment” as recited in claim 16. The office action alleges that *Silverman* discloses this limitation within a negotiating environment at Col. 3, lines 56-64 which states:

It is a further objective of the present invention to provide a negotiated trading system which enables users to enter expressions of interest with respect to a type of transaction, wherein the user need not provide defined or objective criteria necessary to complete the transaction.

It is another objective of the present invention to provide a negotiated trading system which identifies parties who are potentially interested in transacting business and place these parties in communication with one another.

The two objectives provided by *Silverman* do not teach, suggest, or otherwise disclose “advertising an invitation to join a group by posting an advertisement for prospective group members, wherein at least some of the prospective group members are unknown to a user creating the networked environment.” Rather, *Silverman* seeks to identify potentially interested parties through the use of a filtering feature, and by directly notifying the parties of the potential transaction. At column 4, lines 33-41, *Silverman* further describes his system (emphasis added):

Each user enters a first set of transaction parameters including ranking and other information into his or her remote terminal. The matching computer uses the first set of transaction parameters (ranking data, price data, size data and other parameters or attributes) from each user to identify potential transactions with potential counterparties. *If potential transactions are identified, the respective parties are notified so that they may begin negotiation of a second set of transaction parameters.* The second set of transaction parameters which may be negotiated by the parties to the potential transaction identifies by the system may consist of 1) some or all of the parameters in the first set of transaction parameters, 2) some parameters from the first set and other parameters not included in the first set, or 3) only parameters not included in the first set. Both the first and second set of transaction parameters must match before the system will execute a transaction.

Thus, the system described in *Silverman* involves notifying each party of a potential transaction so that they may begin further negotiation. Such a system is not the same as “advertising an invitation to join a group by posting an advertisement for prospective group members” as recited in claim 16. No *invitation* to join a *group* is described or suggested, nor is an *advertisement* described or suggested in *Silverman*.

None of the remaining cited references cure this deficiency. Accordingly, claim 16 is allowable over the cited art. Claims 15, 17-25 and 27-40 each depend from claim 16 and are allowable as being dependent on an allowable base claim, and further in view of additional reasons provided below.

Claim 43 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ludwig* in view of *Stein et al.*, U.S. Pat. No. 5,978,779 (*Stein*). Applicants respectfully traverse this rejection for at least the following reasons.

Claim 43 recites:

A system for implementing a user-defined negotiation environment, comprising:

a first database that stores information concerning a directory of users available to be included as group members in the user-defined negotiation environment;

a second database that stores information concerning the group members included in the user-defined negotiation environment;

a third database comprising a document repository for storing documents available in the user-defined negotiation environment; and

an environment generator comprising a computer program executing steps comprising:

(1) receiving user input from a first user to create a group comprising a plurality of group members, each group member having an associated e-mail address;

(2) receiving user input from the first user selecting a plurality of web-accessible negotiation tools from a list of available tools, wherein the selected tools are provided through a web-based interface and are made available to the plurality of group members over an Internet Protocol (IP) network;

(3) automatically generating a web page accessible to the plurality of group members, and providing access via the web page to the plurality of web-accessible tools selected in step (2); and

(4) providing a group-specific lexicon comprising preferred forms of standard terms used during negotiation for use in the user-defined negotiation environment.

Applicants submit that the combination of *Ludwig* and *Stein*, even if proper, fails to teach or suggest at least a second database that stores information concerning the group members included in the user-defined negotiation environment. *Ludwig* describes databases, but none that separately store information concerning group members. For example, at col. 8, lines 27-40, *Ludwig* describes a multimedia database:

Note in FIG. 3 that Data LAN hub 25, A/V Switching Circuitry 30 and MLAN Server 60 also provide respective lines 25b, 30b, and 60c for coupling to additional multimedia resources 16 (FIG. 1), such as multimedia document management, multimedia databases, radio/TV channels, etc. Data LAN hub 25 (via bridges/routers 11 in FIG. 1) and A/V Switching Circuitry 30 additionally provide lines 25c and 30c for coupling to one or more other MLANs 10 which may be in the same locality (i.e., not far enough away to require use of WAN technology). Where WANs are required, WAN gateways 40 are used to provide highest quality compression methods and standards in a shared resource fashion, thus minimizing costs at the workstation for a given WAN quality level, as discussed below.

At col. 21, lines 11-15, *Ludwig* discloses a "service database":

These service records are entered into the Service Server's service database. The service database thus keeps track of the location of

client programs and the types of collaborative sessions in which they can participate.

In this passage, *Ludwig* merely shows the use of a service database to keep track of the location of programs. Plainly, the databases disclosed in *Ludwig* do not include a second database for storing "information concerning the group members included in the user-defined negotiation environment" as recited in claim 43. None of the remaining cited references cure this deficiency.

In addition, the office action improperly combines *Ludwig* and *Stein*. A prima facie case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

Applicants submit that *Stein* discloses a preferred environment that teaches away from a "user-defined negotiation environment" as claimed. More specifically, *Stein* is directed toward a negotiating environment created, defined, and provided for users by a financial service provider (FSP).

For example, at column 3, lines 40-60, *Stein* writes:

In one preferred embodiment the present invention concerns a database and a system for the management thereof where the financial service provider ("FSP") has access to client, counterparty, and related information without regard to the type and/or source of related information. In other words, the system allows the FSP seamlessly to view relationships between and among all of the entities in the database. For example, a typical brokerage will have individuals and institutions as clients; the brokerage can offer a number of services, including various different account types (e.g., the central assets account described above), various transaction services (e.g., stock trading, commodities trading, wire fund transfers), various products (e.g., money markets, mutual funds), and often access to third parties' (called "counterparties" herein) products and services. Further, those counterparties may elect to conduct transactions through the FSP. For example, a client may invest in a counterparty's mutual fund while that counterparty uses the services of the FSP to buy and sell all or some of the stocks or other instruments of which the mutual fund is comprised.

Thus, according to *Stein*, it is preferable to have a third party (as opposed to a user) to a transaction create a negotiating environment. Such a view is directly contrary to (and teaches away from) the invention of claim 43.

Furthermore, the office action fails to provide any suggestion or motivation to combine the the references. The office action states that combining *Stein* with *Ludwig* would “allow tailoring of negotiations to the particular instruments being negotiated.” Even if this were true, this is not a motivation to combine the references, but rather is a result of the combination itself, and is exactly the type of impermissible hindsight prohibited by the Federal Circuit.

The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should rigorously apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added).

Thus, for this additional reason, claim 43 is allowable. Claims 44-55 depend from claim 43 and are allowable as being dependent from an allowable base claim, and further in view of additional reasons provided below.

### **Dependent Claims**

Claim 25 stands rejected under *Ludwig* in view of *Silverman*. The office action alleges that “*Ludwig* discloses brainstorming in the environment at Col. 1, lines 39-45.” Claim 25 recites:

The method of claim 16, wherein step (3) comprises the step of a selecting an electronic brain-writing tool that permits participants to brainstorm using electronic idea cards.

Applicants submit that the *Ludwig* does not teach or suggest either a “electronic brain-writing tool” or the use of “electronic idea cards” as recited in claim 25. At page 72 of the instant specification, brain writing is described:

Brain writing is a variant of a method for facilitated group discussion termed brainstorming. The objective of brainstorming is to maintain the focus of the discussion while encouraging creative input and recognizing the contributions of all members of the group. It seeks to avoid problems with a few individuals dominating the discussion, with junior staff deferring to senior staff, and with new ideas being abandoned before than can be developed fully. Brain storming has been commonly used since the late 1960s. Brain writing is a more intense method that relies on joint writing rather than discussion.

Plainly, brain-writing is a different exercise than brainstorming. The passage referred to in *Ludwig* merely highlights the effectiveness of visual information in enhancing collaboration. The passage does not disclose an electronic brain-writing tool as recited in claim 25. In addition, the office action fails to point to anything in *Ludwig* that even remotely suggests the use of "electronic idea cards" as recited in claim 25. For this additional reason, claim 25 is allowable over the cited references.

Claim 31 stands rejected under *Ludwig* and *Silverman*. Claim 31 recites:

The method of claim 30, wherein steps (5) and (8) comprise the step of sharing a single anonymous e-mail alias among a plurality of users.

The office action alleges that *Silverman* discloses anonymous trading at Col. 1, lines 26-38. That may be true, but anonymous trading is not the same as "sharing a single anonymous e-mail alias among a plurality of users" as recited in claim 31. The cited portion of *Silverman* merely shows that when brokers are used to complete transactions, anonymity is preserved. It does not teach or suggest "sharing a single anonymous e-mail alias among a plurality of users" as recited in claim 31. For this additional reason, claim 31 is allowable.

Claim 52 stands rejected under *Ludwig* in view of *Stein*. Claim 51 recites:

The system of claim 50, wherein the message comprises a predefined reply-card format.

The office action alleges that "*Ludwig* discloses e-mail, a predefined format at Col. 19, line 49-Col. 20, line 4." Applicants submit that even if *Ludwig* disclosed what is alleged, that is not the same as a "message compris[ing] a predefined reply-card format." As discussed in the specification at page 14, lines 12-19:

A reply card is created by a user when posting a new listing. The lister specifies the information that must be included in a response, and the type of information object to display for the data element (e.g. a text box, check box, radio button). The system then creates an HTML page to collect the requested information. When a respondent clicks "Reply Card" on the listing screen, the page is displayed. All of the responses are automatically entered into a database created automatically when the reply card is composed. As each respondent fills out a reply card, a new record is added to the database of the system and the lister is permitted to view it through an appropriate filter as discussed above.

In contrast, *Ludwig* shows only that a Collaboration Initiator invokes appropriate collaboration tools to manage a collaborative session. This is very different from a message comprising a pre-

defined reply-card format as recited in claim 52. As a result, claim 52 is allowable for this additional reason.

**Conclusion**

If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733 accordingly.

All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same.

Respectfully submitted,

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Dated: July 20, 2004

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